

REMARKS

Claims 1-20 are pending in this application. By this Amendment, claims 1 and 2 are amended. The amendments to the claims introduce no new matter as they are supported by at least Figs. 1 and 3, and the claims as originally filed. Reconsideration of the application is respectfully requested.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Levi during the July 12, 2005 personal interview. Applicants' separate record of the summary of the substance of that interview is contained in the following remarks.

The Office Action, on page 2, rejects claims 1-20 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,560,115 to Wakabayashi et al. (hereinafter "Wakabayashi"). This rejection is respectfully traversed.

Wakabayashi teaches an electronic control unit for mounting on a vehicle including a control portion and a power portion which are separate from each other, and are combined together (Abstract). The Office Action, on pages 2 and 3, describes those elements disclosed in Wakabayashi that are considered to correspond to each of the features recited in at least claims 1 and 2. References to Figs. 1, 2A, 2B and 15 are made in the Office Action's assertion that all of the features recited in claims 1 and 2 are allegedly anticipated by this single reference.

Claim 1 is amended to include a seal member surrounding the circuit arrangement region, wherein, among other features, the seal member is interposed between the wall member and the heat radiating member. As such, claim 1 incorporates the seal member previously recited in dependent claim 2.

With regard to the seal member, the Office Action states that a seal member surrounding the circuit arrangement region allegedly corresponds to elements 22, 23 in Fig. 15 of Wakabayashi. The disclosure of Wakabayashi teaches that, in the prior art, as depicted

in Fig. 15, a waterproof packing 22 is provided at a region of connection between a lid and a connector-incorporating casing 2 and a waterproof packing 23 is provided at a region of connection between the connector-incorporating casing 2 and a heat sink 21 (col. 1, lines 41-45). It is these waterproof packings that are considered by the Office Action to correspond to a seal member surrounding the circuit arrangement region.

Wakabayashi, however, goes on to state, in reference to the waterproof packings 22, 23, "and besides, the packing 22 is used between the lid and the casing 2, and also packing 23 is used between the casing 2 and the heat sink 21, and this increases the production cost" (col. 2, lines 20-23). In providing a structure in which a control circuit and a power circuit are separated from each other so that a control circuit would be less affected by heat generated by the power circuit portion, and teaching an assembly operation in which such a structure can be more easily affected, the Wakabayashi device specifically removes the packing 22, 23 discussed with reference to the prior art. As such, Wakabayashi specifically teaches away from a combination of features that include a seal member.

Applicants' representative presented the above argument in support of the patentability of at least independent claim 1 to the Examiner during the July 12 personal interview. The Examiner argued his belief that the requirements for a showing of anticipation are met. Specifically, the Examiner stated that it was the Patent Office's position that where all of the features recited in the claims were taught by a single prior art reference, those claims were anticipated by the reference. Applicants' representative agreed that this is generally true, but that combining features taught by the prior art into an embodiment of the reference that teaches away from the combination is improper. The Examiner remained unpersuaded by Applicants' representative's arguments in this regard.

Applicants offer the following additional arguments that the embodiment in Fig. 1 of Wakabayashi cannot properly be modified as suggested by the Office Action to include

features of the prior art in Fig. 15. In reviewing the anticipation standard, the Federal Circuit stated "[t]o anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375 (Fed. Cir. 2001), *cert. denied*, 122 S. Ct. 1436 (2002) (emphasis added).

Additionally, other court precedent clarifies the requirements for anticipation based on arguably distinct teachings in a single prior art reference, stating that "the reference ... must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524 (CCPA 1972); *see also Sandisk Corp. v. Lexar Media, Inc.*, 91 F. Supp. 2d 1327, 1336 (N.D. Calif. 2000) (stating that "[u]nless all the elements are found in a single piece of prior art in exactly the same situation and united the same way to perform the identical function, there is no anticipation.") and *Aero Industries Inc. v. John Donovan Enterprises-Florida Inc.*, 53 USPQ2d 1547, 1555 (S.D. Ind. 1999) (stating that "[n]ot only must a prior patent or publication contain all of the claimed elements of the patent claim being challenged, but they 'must be arranged as in the patented device' ").

This standard for anticipation is also set forth in MPEP §2131, which states that "the identical invention must be shown in as much detail as is contained in the . . . claim."

Further, although the same terminology need not be used, "the elements must be arranged as required by the claim."

The Office Action improperly ignores these requirements for anticipation by modifying the embodiment of Fig. 1 of Wakabayashi to introduce a "seal member" arranged as recited in original claim 2. Clearly the standard for anticipation is not met with the combination of the prior art of Fig. 15, which arguably includes a seal member as elements

22, 23, and the Wakabayashi device disclosed in Fig. 1, wherein the alleged seal member is intentionally omitted or removed.

Claim 1 recites, among other features, a seal member surrounding the circuit arrangement region, wherein the seal member is interposed between the wall member and the heat radiating member. For at least the reasons discussed above, Wakabayashi cannot reasonably be considered to anticipate at least this feature of independent claim 1.

Applicants further respectfully submit that the rejection under 35 U.S.C. §102 over Wakabayashi is improper because the rejection relies upon a modification of the teachings of the reference. When the teachings of a reference must be modified to achieve the arrangement of features recited in a claim, rejection under 35 U.S.C. §102 is improper and must be made under 35 U.S.C. §103. Because the unmodified teachings of the reference do not identically disclose or describe "the invention" as recited in the claim, only a rejection under 35 U.S.C. §103 is permissible. Applicants respectfully submit that the rejection of at least claim 2 under 35 U.S.C. §102 over Wakabayashi as set forth in the Office Action impermissibly relies upon a modification of the teachings of Wakabayashi regarding the embodiment of Fig. 1.

Because the rejection over Wakabayashi is under 35 U.S.C. §102, the Office Action does not set forth any alleged motivation for the proposed modification of the embodiment of Fig. 1. Applicants respectfully submit, however, that no proper motivation for the modification relied upon by the Office Action could be established to support a rejection under 35 U.S.C. §103. As discussed above, Wakabayashi specifically teaches away from modification of the embodiment of Fig. 1 to include "seals" as allegedly taught by the prior art of Fig. 15. As set forth in MPEP §2141.02, the reference "must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." Thus, it would be improper to ignore the specific teachings of Wakabayashi to

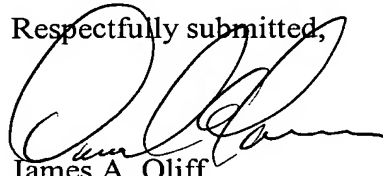
allege motivation to make the modification of the embodiment of Fig. 1 relied upon by the Office Action. As such, a rejection of claim 1 under 35 U.S.C. §103 over Wakabayashi would be improper. Because each of independent claims 13 and 19 also include a seal member, these claims are patentable over Wakabayashi for at least the reasons discussed above with respect to claim 1. Claims 2-12, 14-18 and 20 are also patentable over Wakabayashi for at least the respective dependence of these claims directly or indirectly on independent claims 1, 13 and 19, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-20 under 35 U.S.C. §102(e) over Wakabayashi are respectfully requested.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-20 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



James A. Oliff

Registration No. 27,075

Daniel A. Tanner, III

Registration No. 54,734

JAO:DAT

Attachment:

Petition for Extension of Time

Date: July 26, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
